



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/727,944

12/04/2003

Yusuke Ichikawa

17295

7378

23389

7590

03/11/2009

SCULLY SCOTT MURPHY & PRESSER, PC

400 GARDEN CITY PLAZA

SUITE 300

GARDEN CITY, NY 11530

EXAMINER

YABUT, DIANE D

ART UNIT

PAPER NUMBER

3734

MAIL DATE

DELIVERY MODE

03/11/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/727,944

Applicant(s)

ICHIKAWA, YUSUKE

Examiner

DIANE YABUT

Art Unit

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This action is in response to applicant's amendment received on 05/30/2008.

The examiner acknowledges the amendments made to the claims.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 5 there is an inconsistency in the language of the preamble and that of body of the claim thus making their scope unclear. The preamble recites "an ultrasonic puncture needle" thus indicating that the claims are directed to the subcombination, the needle. However lines 2-3 positively recite "which is inserted into a treatment insertion channel of an ultrasonic endoscope," thereby reciting the ultrasonic endoscope as an element of the invention, and indicating that the claims are directed to the combination of the ultrasonic puncture needle and the ultrasonic endoscope. As such it is unclear whether applicant intends the claims to be drawn to the combination or the subcombination. Applicant is hereby required to indicate which, the combination (the ultrasonic puncture needle and the ultrasonic endoscope) or subcombination (the ultrasonic puncture needle) the claims are intended to be drawn and make the language consistent with this intent. For examination purposes, the claims will be considered as

drawn to the combination, the ultrasonic puncture needle and the ultrasonic endoscope.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ouchi** (U.S. Patent No. **6,238,336**) in view of and **Masatoshi** (JP **11076254**) and **Hoyns** (U.S. Patent No. **5,759,154**).

Ouchi discloses an ultrasonic endoscope with a sheath **100** which is inserted into a treatment tool insertion channel **13** of the ultrasonic endoscope and a pipe-shaped needle tube **101** for being inserted into tissue within the body cavity through the sheath which includes a cutting tip portion formed in a sharp shape with a smaller cross-section in a tip-ward direction, the cutting tip portion being provided on a tip side of the needle tube (Figure 1, col. 4, lines 15-20).

Ouchi also discloses a tube portion formed in the shape of a tube at the rear end of the puncturing portion of needle **101**, and a tube-shaped portion formed as an extension of the tube portion (Figure 1, col. 4, lines 15-20).

Ouchi does not expressly disclose having a plurality of staggered-array annular-shaped recesses having flat surfaces on bottoms and sides thereof and provided from a back surface of the cutting tip portion near a tip of the needle tube to a predetermined

range on a surface of a tip portion of the needle tube, which is an area excluding the cutting tip portion.

Masatoshi teaches an ultrasonic needle tube **1** with annular-shaped recesses **30** located in an area excluding a cutting tip portion (Figures 4-5). It would have been obvious to one of ordinary skill in the art at the time of invention to provide annular-shaped recesses being formed at positions such that overlap of the recesses and the cutting-tip portion does not occur, as taught by Masatoshi, to Ouchi in order to project the positioning of the needle under an ultrasonic image clearly, safely, and reliably while preventing interference of the piercing function.

Hoyns teaches an ultrasonic puncture needle with recesses being in a staggered-array and having flat surfaces on bottoms and sides thereof (Figures 1A-2). It would have been obvious to one of ordinary skill in the art at the time of invention to provide recesses being in a staggered-array and having flat surfaces on bottoms and sides thereof, as taught by Hoyns, to Ouchi in order to provide a stronger return signal of an incident ultrasound beam to the ultrasound array and a more specular reflection of an ultrasound beam at shallow angles of incidence (col. 3, lines 33-38).

Response to Arguments

3. Applicant's arguments with respect to claims 1-19 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **DIANE YABUT** whose telephone number is (571)272-6831. The examiner can normally be reached on **M-F: 9AM-4PM EST**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on (571) 272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Diane Yabut/
Examiner, Art Unit 3734

/Todd E Manahan/
Supervisory Patent Examiner, Art Unit 3734